

REMARKS

By this amendment, claims 2-6, 9-13, 16-18, 20 and 21 remain canceled. Claims 1, 8, 15 and 19 have been amended. Claims 1, 8, 15 and 19 remain in the application. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, and allowance of the application, as amended, is requested.

Objection to the Claims

Claim 1 was objected to because of informalities. This objection is traversed for at least the following reasons. As now presented, claim 1 has been amended and semi-colons are included at the end of each limitation. The term "and" after the semi-colon of the second to last limitation has been deleted, in view of the addition of the third limitation. The "wherein" clauses of claim 1 have been rejoined to the tail-end of the second limitation by deleting the carriage return and tab preceding the respective "wherein" clauses. In addition, the "wherein" clauses provide further definition of previously introduced subject matter of the same or previous limitation. Objection to the claim is now believed overcome.

Rejection under 35 U.S.C. §103

Claim 1:

Claim 1 recites a method of enabling to identify a specific broadcast driven group of peers among multiple groups of peers on a peer-to-peer network, the method comprising:

providing a specific identifier of multiple identifiers for linking a content broadcast to the specific group of peers;

deriving at an end-user site the specific identifier (i) from a further identifier embedded in a broadcast stream of the content broadcast in response to a reception of the content broadcast or (ii) from a further identifier embedded in an electronic program guide (EPG) in response to selecting the content broadcast from the EPG, the further identifier being representative of the content broadcast,

wherein the further identifier comprises a TV-anytime Content Reference Identifier, and wherein the TV-anytime Content Reference Identifier is resolved into a peer group ID as part of the step of deriving; and
responsive to deriving the specific identifier, enabling a connection to the specific group of peers via the peer-to-peer network within a context of the content broadcast.

Support for claim 1 (as well as for claims 8, 15 and 19) can be found in the specification at least on page 2, lines 25-28; page 3, lines 3-6, 24-25 and 32-34; page 4, lines 3 and 17-18; and page 5, lines 11-12.

As presented, claim 1 clearly articulates a novel and non-obvious method of enabling to identify a specific *broadcast driven* group of peers among multiple groups of peers on a peer-to-peer network within the *context* of a *content broadcast* (See, for example, the present specification on page 4, lines 17-18). In other words, the method of claim 1 advantageously enables peers to connect and interact via the P2P network within the context of the broadcast.

Claims 1, 8, 15 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. US 2003/0237097 A1 to *Marshall et al.* ("**Marshall**") in view of U.S. Patent Publication No. US 2002/0156875 A1 to *Pabla, Kuldipsingh* ("**Pabla**") and further in view of U.S. Patent Publication No. 2003/0120634 A1 to *Koike et al.* ("**Koike**"). With respect to claim 1, Applicant respectfully traverses this rejection on the grounds that the references are defective in establishing a prima facie case of obviousness.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness ...

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for at least the following reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The **Marshall**, **Pabla**, and **Koike** references cannot be applied to reject claim 1 under 35 U.S.C. §103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither **Marshall**, **Pabla**, nor **Koike** teaches a method of enabling to identify a specific *broadcast driven* group of peers that includes “deriving *at an end-user site* the *specific identifier (i)* from a further identifier embedded in a broadcast stream of the content broadcast *in response to a reception of* the content broadcast or *(ii)* from a further identifier embedded in an electronic program guide (EPG) *in response to selecting* the content broadcast from the EPG ... the further identifier ... representative of the content broadcast ... comprises a TV-anytime Content Reference Identifier ... resolved into a peer group ID ... and *responsive to deriving the specific identifier*, enabling a connection to the *specific group of peers* via the peer-to-peer network within a *context of the content broadcast*” (emphasis added) as is claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

In contrast, the **Marshall** reference is directed to peer to peer acquisition in P2P technology utilized to allow a PVR to obtain copies of past broadcasts, enabling

recording of past broadcasts that have been cached or otherwise saved by a peer device (see Marshall abstract and paragraph [0001]), and more particularly, to a method for *searching* for a particular broadcast (see Marshall FIG. 3). Accordingly, the **Marshall** reference does not teach or suggest a method of enabling to identify a specific *broadcast driven* group of peers that includes “*deriving at an end-user site the specific identifier (i) from a further identifier embedded in a broadcast stream of the content broadcast in response to a reception of the content broadcast or (ii) from a further identifier embedded in an electronic program guide (EPG) in response to selecting the content broadcast from the EPG ... the further identifier ... representative of the content broadcast ... comprises a TV-anytime Content Reference Identifier ... resolved into a peer group ID ... and responsive to deriving the specific identifier, enabling a connection to the specific group of peers via the peer-to-peer network within a context of the content broadcast*” as recited in claim 1.

In further contrast, the **Pabla** reference is directed to a peer group name server for providing a name service in a peer-to-peer environment, and more particularly, to a peer group name server that caches information about peers, peer groups and other entities (see Pabla abstract). The **Pabla** reference further discloses a peer group name server that serves as a *reverse lookup* provider, to enable *discovering* peers in the peer group (see Pabla at paragraph [0060]). Accordingly, the **Pabla** reference does not teach or suggest a method of enabling to identify a specific *broadcast driven* group of peers that includes “*deriving at an end-user site the specific identifier (i) from a further identifier embedded in a broadcast stream of the content broadcast in response to a reception of the content broadcast or (ii) from a further identifier embedded in an electronic program guide (EPG) in response to selecting the content broadcast from the EPG ... the further identifier ... representative of the content broadcast ... comprises a TV-anytime Content Reference Identifier ... resolved into a peer group ID ... and responsive to deriving the specific identifier, enabling a connection to the specific group of peers via the peer-to-peer network within a context of the content broadcast*” as

recited in claim 1.

In still further contrast, the **Koike** reference is directed to a data processing system and method in which an *interest vector* is configured using a parameter indicating a *degree of interest* in each category based on *user interest information received by a control server* on a peer-to-peer network (see Koike abstract). The **Koike** reference further discloses that “user interest information is used to efficiently retrieve desired content without adding metadata to the content” and “thereby achieving better content retrieval efficiency on a peer-to-peer (P2P) network” (see Koike at paragraph [0009]). Accordingly, while the **Koike** reference does disclose use of a CRID, the **Koike** reference does not teach or suggest a method of enabling to identify a specific *broadcast driven* group of peers that includes “deriving *at an end-user site* the *specific identifier (i)* from a further identifier embedded in a broadcast stream of the content broadcast *in response to a reception of* the content broadcast or *(ii)* from a further identifier embedded in an electronic program guide (EPG) *in response to selecting* the content broadcast from the EPG ... the further identifier ... representative of the content broadcast ... comprises a TV-anytime Content Reference Identifier ... resolved into a peer group ID ... and *responsive to deriving the specific identifier*, enabling a connection to the *specific group of peers* via the peer-to-peer network within a *context* of the *content broadcast*” as recited in claim 1.

For this reason, the examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness

In the present case the **Koike** reference, by providing that “user interest information is used to efficiently retrieve desired content without adding metadata to the

content” and “thereby achieving better content retrieval efficiency on a peer-to-peer (P2P) network” (see Koike at paragraph [0009]), is directed to a system in which a metadata or specific identifier is not added to content. Thus, this system clearly teaches away from claim 1, recited above.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason alone, the examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

3. The Combination of References is Improper

Assuming, *arguendo*, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is still another compelling reason why the **Marshall**, **Pabla**, and **Koike** references cannot be applied to reject claim 1 under 35 U.S.C. §103.

§ 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant’s disclosure, refrain from using hindsight, and consider the subject matter claimed ‘as a whole’.

Here, neither **Marshall**, **Pabla** nor **Koike** teaches, or even suggests, the desirability of the combination since no one of the references teach a method of enabling to identify a specific *broadcast driven* group of peers that includes “deriving at an end-user site the specific identifier (i) from a further identifier embedded in a broadcast stream of the content broadcast *in response to a reception of* the content

broadcast or (ii) from a further identifier embedded in an electronic program guide (EPG) *in response to selecting* the content broadcast from the EPG ... the further identifier ... representative of the content broadcast ... comprises a TV-anytime Content Reference Identifier ... resolved into a peer group ID ... and *responsive to deriving the specific identifier*, enabling a connection to the *specific group of peers* via the peer-to-peer network within a *context of the content broadcast*" as specified above and as claimed in claim 1.

Thus, it is clear that none of the references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In this context, the MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the combination presented in the Office Action arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. The 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is respectfully requested.

Claims 8, 15 and 19 contain limitations similar to those of claim 1. Accordingly, for similar reasons as stated with respect to overcoming the rejection of claim 1, claims

8, 15 and 19 are believed allowable and an early formal notice thereof is requested. The 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is respectfully requested.

Conclusion

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claims 1, 8, 15 and 19 are in condition for allowance.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. An early formal notice of allowance of claims 1, 8, 15 and 19 is requested.

Respectfully submitted,

/Michael J. Balconi-Lamica/

Michael J. Balconi-Lamica
Registration No. 34,291
for Edward Goodman, Reg. No. 28,613

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Philips Intellectual Property & Standards
345 Scarborough Road
Briarcliff Manor, New York 10510
Telephone: 914-333-9611
Facsimile: 914-332-0615
File: NL031487US1

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